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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/886,516	07/01/1997	WILLIAM BERSON	E-621	8901

919 7590 06/07/2004

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EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 06/07/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

08/886,516

Applicant(s)

BERSON ET AL

Examiner

Matthew B Smithers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,365,586 granted to Indeck et al and further in view of U.S. patent 5,940,504 granted to Griswold.

Regarding claim 1, the Indeck reference discloses a method and apparatus for fingerprinting magnetic media. This fingerprint may be affixed to an object of manufacture in order to verify and authenticate the object, (see Abstract). With respect to claim 1, step a, the label with unreproducible pattern is disclosed as column 6, lines 23-28; step b, processing the unreproducible pattern and including processed unreproducible pattern with the information relating to the article at column 4, lines 30-35 and Figure 3; step c, encrypting a portion of the information at column 2, lines 35-45; and step d, securely associating the article, the label and a tangible representation of the encrypted information at column 3, lines 5-10. However, Indeck fails to specifically teach controlling and monitoring the production of the article of manufacture between the licensor and licensee. Griswold teaches a license management system in which the use of a licensed product is controlled in accordance with the terms of the license

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agreement (see Abstract). Griswold further teaches a license monitor communicates regularly with a license control system to describe information related to the use of the licensed product (see column 5, lines 19-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Indeck's fingerprint magnetic media with Griswold's method of monitoring the use of licensed products for the purpose of tracking the use of a licensed product to ensure that audio and video vendors are properly credited with the royalties for their licensed material (see column 2, lines 27-37).

Regarding claim 2, Indeck as modified teaches information for verifying (see Indeck; column 4, lines 8-18).

Regarding claim 3, Indeck as modified teaches verifying information consisting of information about the article of manufacture (see Indeck; column 4, lines 24-40).

Regarding claim 5, Indeck as modified teaches embedded magnetic fibers (see Indeck; column 3, lines 54-62 and column 4, lines 35-38).

Regarding claim 6, Indeck as modified is met by the description at column 4, lines 35-38 of Indeck.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,365,586 granted to Indeck et al and further in view of U.S. patent 5,940,504 granted to Griswold and U.S. patent 5,638,446 granted to Rubin.

Indeck as modified discloses verification using the publicly known key at column 4, lines 35-38. However, the instant claims provide for signing of the public key by a trusted third party. The patent to Rubin teaches a secure distribution of electronic files. The files are signed by the source of the files (the authors) and the public key of the authors is signed with the secret key of a trusted third party, see Figure 2, blocks 30, 32, and 34. It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to sign the public key of the source as taught in Rubin in order to provide a public key of a source with the certification of a trusted third party.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Grumstrup et al (US 6,023,763) discloses a method for preventing unauthorized installation and use of a licensed software program.

B. Richardson, III (US 5,490,216) discloses registering a licensed software product through the use of a permit code.

C. Waite et al (US 5,222,134) discloses a system for activating licensed personal computer software at remote locations.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

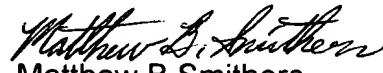
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew B Smithers
Primary Examiner
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